

Application No. 10/648,259

**IN THE DRAWINGS:**

Please amend Figure 1 as illustrated in red on the attached photocopy. Figure 1 has been amended to remove the references to "hypertension" in box 4 and "N unit XY" in box 41 and 411.

## **REMARKS**

### **Claim Rejections**

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1 and 2 are rejected under 35 U.S.C. §103(a) as being unpatentable over Westerinen et al. (2004/0088589) and Chan et al. (2004/0181616). Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Westerinen et al. and Chan et al. as applied to claim 1 above, and further in view of Steigerwald et al. (2004/0032239).

### **Drawings**

It is noted that the Examiner has accepted the drawings as originally filed with this application. However, in order to have Figure 1 correspond with the amendments to the specification, Applicant proposes to amend Figure 1, as illustrated in red on the attached photocopies, to remove the references to "hypertension" in box 4 and "N unit XY" in boxes 41 and 411.

### **Substitute Specification**

It was felt that the most expeditious way of correcting the numerous grammatical and idiomatic inaccuracies present in the specification as filed was the preparation of a Substitute Specification. It is believed that the Substitute Specification overcomes the outstanding objections to the specification. The Substitute Specification is attached hereto and is accompanied by a marked-up copy of the original specification which indicates the changes made thereto by the Substitute Specification. No "new matter" has been added to the original disclosure by the Substitute Specification. Entry of the Substitute Specification is respectfully requested.

### **Amended Claims**

By this Amendment, Applicant has amended claims 1-3 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject

matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Applicant's amended claims are directed towards a multiple-purpose power supply having a system main power supply which provides power to the central processor and hard drive, ***while an auxiliary power supply provides power to at least one computer peripheral appliance to allow operation of the computer peripheral appliance regardless of whether the system main power supply is turned on or off.*** Dependent claims are further directed towards a multiple-purpose power supply having: an auxiliary power supply with multiple auxiliary control power circuits and two or more sets of auxiliary power output terminals for supplying power to a variety of peripheral appliances; and an auxiliary power supply with an independent coil.

Westerinen et al. teach a standard computer power supply. As admitted by the Examiner on p. 3 of the most recent Office Action, "Westerinen et al. fails to teach permitting operation of computer peripheral appliances, whether the computer main system is switched on or off."

It follows that Westerinen et al. does not teach: a multiple-purpose power supply having a system main power supply which provides power to the central processor and hard drive, while an auxiliary power supply provides power to at least one computer peripheral appliance to allow operation of the computer peripheral appliance regardless of whether the system main power supply is turned on or off. Westerinen et al. also does not teach a multiple-purpose power supply having: an auxiliary power supply with multiple auxiliary control power circuits and two or more sets of auxiliary power output terminals for supplying power to a variety of peripheral appliances; and an auxiliary power supply with an independent coil.

The Examiner cites Chan et al. as supplying Westerinen et al.'s aforementioned deficiency. However Chan et al. teaches software with a dual operating mode system. Applicant believes this system is merely a software based power management system similar to "sleep" and "awake" functions of a Windows PC. The Examiner cites the Abstract as teaching "an operating mode where when the computer main system is turned off, it still allows for the peripheral devices to continue operation." However, it is important to note that this software-based

approach for controlling a single, main power supply does not teach a separate auxiliary power supply which can power peripheral devices when the main power supply is switched off. Chan et al.'s system merely lowers the power consumption of the main power supply.

Chan et al. does not teach: a multiple-purpose power supply having a system main power supply which provides power to the central processor and hard drive, while an auxiliary power supply provides power to at least one computer peripheral appliance to allow operation of the computer peripheral appliance regardless of whether the system main power supply is turned on or off. Chan et al. also does not teach a multiple-purpose power supply having: an auxiliary power supply with multiple auxiliary control power circuits and two or more sets of auxiliary power output terminals for supplying power to a variety of peripheral appliances; and an auxiliary power supply with an independent coil.

Steigerwald et al. is cited as teaching an independent coil N1. The Examiner has stated that the motivation for combining this coil N1 with "it is a known system that works in the art and Westerinen doesn't explicitly teach what the inner circuitry is." Applicant's respectfully submit, that, as discussed in more detail below, this is not an adequate motivation. The Examiner must do more than indicate two references are in the same field and show that a combination is *possible*.

In any event, Steigerwald et al. does not teach a multiple-purpose power supply having a system main power supply which provides power to the central processor and hard drive, while an auxiliary power supply provides power to at least one computer peripheral appliance to allow operation of the computer peripheral appliance regardless of whether the system main power supply is turned on or off. Steigerwald et al. also does not teach a multiple-purpose power supply having: an auxiliary power supply with multiple auxiliary control power circuits and two or more sets of auxiliary power output terminals for supplying power to a variety of peripheral appliances; and an auxiliary power supply with an independent coil.

Even if the teachings of Westerinen et al., Chan et al., and Steigerwald et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a multiple-purpose power supply having a system main power supply which provides power to the central processor and hard drive, while an auxiliary

power supply provides power to at least one computer peripheral appliance to allow operation of the computer peripheral appliance regardless of whether the system main power supply is turned on or off.

Nor does the combination suggest a multiple-purpose power supply having: an auxiliary power supply with multiple auxiliary control power circuits and two or more sets of auxiliary power output terminals for supplying power to a variety of peripheral appliances; or an auxiliary power supply with an independent coil.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the

claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Westerinen et al., Chan et al., or Steigerwald et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Westerinen et al., Chan et al., nor Steigerwald et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

### **Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best

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be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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